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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/019,530

01/03/2002

Leslie Gray Graf

4009-63

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08/09/2006

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EXAMINER

LEE, CHI HO ANDREW

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/019,530	<b>Applicant(s)</b> GRAF ET AL.	
	<b>Examiner</b> Andrew Lee	<b>Art Unit</b> 2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Bjelland et al U.S. Patent Number 6,856,612.

Re Claims 1, 6, fig. 7 teaches a GW 770 coupled to GSM wireless circuit network (first network based on a first technology) and PSTN (a second network based on a second technology, See fig. 4) whereby the GW 770 enables TFO inband capability negotiation on the circuit switched leg with an negotiation clone over the IP leg to enable end-to-end transcoding (in order to establish the format for the passing) of the multimedia information (See col. 6, lines 25-66), wherein the band messages are carried in a channel of PSTN (circuit switched network).

Re Claims 2, 3, 7, refer to Claim 1.

Re Claims 4, 8, refer to Claim 1, wherein the further teaches the destination GW 780 coupled to another GSM network (a third network based on first technology) for passing of the TFO message, wherein the GW 780 inherently includes an interface (interface means).

Re Claims 5, 11, refer to Claim 1, wherein the TFO message negotiates codec information (compressed audio stream).

Re Claim 9, refer to Claim 6, wherein GSM is an PLMN.

Re Claim 10, refer to Claim 6, wherein IP backbones supports plurality of service providers (a plurality of telecommunication networks).

Re Claim 12, refer to Claim 6, wherein the first network is a multimedia network.

Re Claim 13, refer to Claim 6, See fig. 4 teaches the GSM wireless network coupled to the PSTN 180 (the second network) that supports SS7 based network.

Re Claims 14, 22, 23, fig. 5 teaches H.323/SIP mobile 340 (a first node) in a GSM network 300 (a first multimedia network) and PC telephone 350 (a second node) in PSTN (a second multimedia network) wherein the networks are separated by an IP backbone 320 (telecommunication transit network) wherein the ISP POP includes GW router interface receives TFO inband capability negotiation message (a control message) from 300 and perform mapping of the message to the transmitted over the IP leg 320 to enable end-to-end transcoding (in order to establish the format for the passing) of the multimedia information (See col. 6, lines 25-66).

Re Claim 15, refer to Claim 14, the IP backbone supports SS7.

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Re Claim 16, refer to Claim 14, wherein the IP backbone is not tied to underlying user plane transport.

Re Claims 17-19, refer to Claim 15, fig. 5 supports GSM TFO inband signaling.

Re Claims 20, 21, refer to Claim 14.

Re Claims 24-27, refer to Claim 1, wherein the PSTN network supports PCM sampling of one or more bits in its traffic channel (bearer channel or channel).

### ***Response to Arguments***

3. Applicant's arguments filed 6/30/06 have been fully considered but they are not persuasive.

Applicant argues that "inband message carried in a channel of an ...circuit switched network" is not found in '612 patent.

However, Examiner disagrees.

Re Claims 1, 6, 14, and 22, "in band message" is carried over a channel of an circuit switched network (See abstract). Furthermore, The transfer of information between the two circuit networks via the IP network reads on "in band message be carried in a channel of an circuit switched network." because the claim limitation does not limit such transfer.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Lee whose telephone number is 571-272-3130. The examiner can normally be reached on Monday to Friday from 8:30AM to 6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AL  
8/3/06

**ANDREW C. LEE**  
**PRIMARY PATENT EXAMINER**

A handwritten signature in black ink, consisting of a stylized, flowing line that starts with a small loop and ends with a horizontal stroke.